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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,877	09/29/2006	Michael Flehinghaus	FLEHINGHAUS ET AL-1 PCT	8126
25889 7590 02/14/2008 COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER SAWHNEY, HARGOBIND S	
			ART UNIT 2885	PAPER NUMBER
			MAIL DATE 02/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/594,877

**Applicant(s)**

FLEHINGHAUS ET AL.

**Examiner**

HARGOBIND S. SAWHNEY

**Art Unit**

2885

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 9/29/2006

### **DETAILED ACTION**

1. The preliminary amendment filed on September 29, 2006 has been entered.

Accordingly:

- The specification has been amended; and claims 1-13 have been amended.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 3 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 (amended), lines 3 and 4, the limitations with phrases "and/or" and "is/are" are not recited in definite manner. Rephrasing of the limitations is needed.

Claim 3 (amended), line 4" selected from group of "should be rephrased as -- selected from a group consisting of --.

As each of claims 3 and 10 has similar deficiencies as that discussed above, claims 3 and 10 are also rejected.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that.

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No.: 5,169,707 (Faykish et al.).

Regarding claims 1 and 2, Faykish et al. discloses a visible display element 10 (Figure 1) comprising:

- a light scattering plastic element 12 including transparent scatter bodies 16 embedded in its mass (Figure 1, column 3, lines 47-53);
- the transparent plastic mass including poly carbonate material (Figure 1, column 8, lines 20-23; and column 12, lines 50-53); a cover 14 including recesses 13;

Note: The limitation “the recesses may be produced preferably by a way of laser processing” has not been given patentable weight.

Patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966.

- the cover layer 14 being colored – dark or bright being interpreted as operational requirement - (Figure 1, claims 10 and 11); the light-scattering

elements 16 being optically integrated into operating system – interpreted as the system including the device 10- and being an operating element of the device 10 (Figure 1);

- The device 10 capable of being designed as: a combination instrument, a multi-dimensional light distributor, a three-dimensional surface structure, or a warning sign - Functional language presenting intended uses- (Figure 1).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 5,169,707 (Faykish et al.).

Faykish et al. discloses a visible display element including a cover layer overlaying entire surface of the a light scattering element as applied to claim 1 discussed in section 5 above. However, Faykish et al. does not specifically teach the cover layer covering only a part of the light-scattering element.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the illuminable device of Faykish et al. by providing a cover layer covering a portion of the light-scattering element instead of providing the cover layer overlaid over the entire surface, since it has been held that rearranging parts of a prior art structure involves only routing skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). The device disclosed by Faykish et al. would function equally well with a cover layer employed for partial covering of the light-scattering element.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

P. V. Palmquist (US Patent No.: 2,354,048), Iwata et al. (US Patent No.: 6,11,699), Nelson et al. (US Patent No.: 6,190,757 B1), Etori et al. (US Patent No.: 6,348,960 B1), Bacon, Jr. Nelson et al. (US Patent No.: 6,548,164 B1) and Mann et al. Nelson et al. (US Patent No.: 7,255,909 B2)

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S. Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 8:00 AM - 4:30 PM 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jong-Suk (James) Lee can be reached on 571 272 7044. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hargobind S Sawhney/  
Primary Examiner, Art Unit 2885